

PATENT
Application 10/737,289
Attorney Docket 2002-0377 (1014-046)

REMARKS

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

Each of claims 1 and 18-20 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Support for the amendments to each of claims 1 and 18-20 can be found in the application as originally submitted at least at paragraph 72. It is respectfully submitted that no new matter has been introduced.

Claims 1-20 are now pending in this application. Each of claims 1 and 19-20 is in independent form.

I. The Objections to Claims 1-20

Claim 1 was objected to because of "acronyms, such as 'IP', 'PCM', 'VoIP', 'DSO' and 'TDM'". Each of claims 1 and 19-20 has been amended to spell out each acronym. Therefore, it is respectfully submitted that any grounds for these objections has been removed, and respectfully request acknowledgment thereof.

Each of claims 1-2, 8, 15-16, 19-20 was objected to because:

Claim 1 recites the limitation 'adapted to' in line 4. *In re Hutchinson*, it has been held that an element 'adapted to' performing a function is not a positive limitation in any patentable sense but only requires the ability to perform. *In re Hutchinson*, 154 F.2d 135, 138 (CCPA 1946); 69 U.S.P.Q. 138. Also see MPEP § 2111.04. A similar thing holds for claims 2, 8, 15-16, 19-20.

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With all due respect, the MPEP is not the law. Moreover, *In re Hutchison* was decided 20 years prior to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) and thus, could not have used the obviousness criteria established by *Graham*. In over 60 years since *In re Hutchison* was decided, no appellate court has cited *In re Hutchison* as authority for a premise that “an element ‘adapted to’ perform[] a function is not a positive limitation in any patentable sense but only requires the ability to perform”, as asserted by the present Office Action. For at least these reasons, *In re Hutchison* is no longer valid law in view of *Graham* and subsequent case law regarding the claim phrase “adapted”.

The predecessor court to the Federal Circuit has interpreted the phrase “adapted” as preceding a “structural limitation”. See, *In re Venezia*, 530 F.2d 956 (CCPA 1976). Claim limitations preceded by “adapted” have been considered sufficiently definite. See MPEP 2173.05(g).

In addition, the Federal Circuit has interpreted the word “adapted” as preceding “functional language [that] limits the scope of these claims to devices that have the capability of” performing the stated function. See, *R.A.C.C. Indus., Inc. v. Stun-Tech, Inc.*, 178 F.3d 1309, 49 USPQ2d 1793 (Fed. Cir. 1998) (*cert. denied*, 526 U.S. 1098 (1999)) (cited with approval by MPEP 2106.IV.B). Because such functional language serves as a claim limitation, a reference cited to support a rejection of a claim must describe a structure(s) capable of performing each claimed function preceded by the term “adapted.”

Further, in the case of *In re Land*, the CCPA ruled on a relevant claim that stated “said color-providing substances associated with at least the inner photosensitive emulsion layers are *adapted to be rendered diffusible* in said liquid composition *only after at least substantial development* of the next outermost photosensitive ... layer has occurred.” See, *In re Land*, 368 F.2d 866, 151 USPQ 621, 635 (CCPA 1966). The CCPA noted that the italicized portions of the claim were functional and held the claim patentable in view of the **functional limitations**.

The objections to each of claims 1-2, 8, 15-16, 19-20 has no legal basis whatsoever. The cases of *In re Venezia*, *R.A.C.C. Indus., Inc.*, and *In re Land* represent binding authority that limitations following the phrase “adapted to” are patentable limitations.

For at least these reasons, reconsideration and withdrawal of each objection to each of claims 1-2, 8, 15-16, 19-20 is respectfully requested.

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II. The Obviousness Rejections

Each of claims 1-20 was rejected under 35 U.S.C. 103(a) as being obvious, and thus unpatentable, over various combinations of U.S. Patent 6,252,952 ("Kung"), and/or U.S. Patent 6,487,196 ("Verthein"). Each of these rejections is respectfully traversed as moot in view of the present amendments to each of claims 1 and 18-20.

Specifically, each of independent claims 1, 19, and 20 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "the VoIP channelized router adapted to route the IP packet call to a Hybrid IP Digital Loop Carrier system, the IP packet call converted to a multiple DS0 digital signal".

Claim 18 states, *inter alia*, yet no substantial evidence has been presented that the relied-upon references teach, a "the VoIP channelized router adapted to encode frequency modulation radio station signals into a high fidelity audio that is transported over an ACCUNET 1.5 service".

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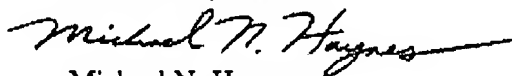
CONCLUSION

It is respectfully submitted that the application is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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